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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,895	01/17/2002	Michael Hesse	52137	2610

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EXAMINER

HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
1755	4

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/046,895	HESSE ET AL.
	Examiner Patricia L. Hailey	Art Unit 1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 March 2002.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-9 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

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*Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Documents were filed on March 26 2002.

*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The phrase "obtainable by" in claim 1 renders the instant claims indefinite because the phrase alludes to any of a variety of known process steps employed to meet the process limitations recited in the instant claims.

Claims 8 and 9 are indefinite because they are not considered to be in proper dependent form.

Neither claim 8 nor claim 9 further limit the product or catalyst recited in claim 1. Claim 8 merely recites apparatus limitations that further limit the process limitations recited in the catalyst of claim 1, but does not further limit the catalyst. Additionally, claim 9 describes a process for preparing the catalyst of claim 1, and does not further limit the catalyst itself.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**5. Claims 1-3 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Gembicki et al. (U. S. Patent No. 4,036,784).**

Gembicki et al. teach an extruded catalyst composition. The catalyst composition is prepared by admixing a peptizing agent and a refractory inorganic oxide (e.g., alumina, silica, zirconia, boria, magnesia, titania; see col. 2, lines 41-53) and water to produce a mixture, which is subjected to shear mixing and extrusion, followed by drying and calcining. See col. 3, lines 10-22 and col. 4, lines 15-30 of Gembicki et al.

The extruded product (considered to read upon the claimed "core") is useful in combination with Group VIB and Group VIII metal components to produce a hydrotreating catalyst. The metal components (considered to read upon the claimed "catalytically active material") may be impregnated onto the extrudate, or may be co-extruded with the extrudate. See col. 4, lines 31 to col. 5, line 36 of Gembicki et al.

The limitations of claim 7 are considered inherently taught by Gembicki et al. in view of the reference's teachings of the claimed catalyst components and the coextrusion thereof.

In view of these teachings, Gembicki et al. anticipate claims 1-3 and 7-9.

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6. **Claims 1-3, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tenten et al. (U.S. Patent No. 6,169,214).**

Tenten et al. teach a coated catalyst consisting of a hollow cylindrical carrier and a catalytically active oxide material applied to the outer surface of the carrier. See col. 6, lines 2-8 of Tenten et al.

Examples of the carrier include alumina, silica, silicon carbide, zirconium dioxide, etc. See col. 7, lines 8-15 of Tenten et al.

Examples of the catalytically active oxide material are those that are already in oxide form, or are in the form of compounds that can be converted into oxides by heating. See col. 10, lines 1-62 of Tenten et al., which also teaches metals or metal compounds that read upon the limitation "5<sup>th</sup> to 8<sup>th</sup> transition group of the Periodic Table, groups IB or IIB,..." as recited in claim 2.

The catalysts are useful in various gas-phase oxidation processes, e.g., the preparation of acrylic acid from acrolein. See col. 11, line 40 to col. 12, line 26 of Tenten et al.

The limitations of claim 7 are considered inherently taught by Tenten et al. in view of the reference's teachings of the claimed catalyst components and the coextrusion thereof.

In view of these teachings, Tenten et al. anticipate claims 1-3, 7, and 8.

7. **Claims 1, 2, 4, 7, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Thompson et al. (U.S. Patent No. 6,297,185).**

Thompson et al. teach a catalyst comprising an electrically conductive ceramic substrate having at least one noble metal supported thereupon. See col. 2, lines 63-65 of Thompson et al.

Examples of the electrically conductive ceramic substrate include carbides and nitrides of transition metals (considered to read upon the phrase "inorganic nitrides or carbides"). See col. 3, lines 6-19 of Thompson et al., as well as Example 1, which employs a catalyst comprising platinum supported on tungsten carbide.

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Examples of the noble metals include platinum and alloys thereof. See col. 4, lines 1-11 of Thompson et al.

In view of these teachings, Thompson et al. anticipate claims 1, 2, 4, 7, and 8.

*Allowable Subject Matter*

8. Claims 5 and 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

The cited references do not teach or suggest the limitations of claims 5 and 6, namely the compositions comprising the support material or precursor thereof and the composition comprising the catalytically active material or precursor thereof.

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (703) 308-3317. The examiner can normally be reached on Mondays-Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.

*Lynn Hailey*

Lynn Hailey/plh  
Examiner, Art Unit 1755  
July 24, 2003

*Mark L. Bell*  
Mark L. Bell  
Supervisory Patent Examiner  
Technology Center 1700